



IMAGE

Robert Greene Sterne
Edward J. Kessler
Jorge A. Goldstein
David K.S. Cornwell
Robert W. Esmond
Tracy-Gene G. Durkin
Michele A. Cimbala
Michael B. Ray
Robert E. Sokohl
Eric K. Steffe
Michael Q. Lee
Steven R. Ludwig
John M. Covert
Linda E. Alcorn
Robert C. Millonig
Lawrence B. Bugaisky
Donald J. Featherstone
Michael V. Messinger

Judith U. Kim
Timothy J. Shea, Jr.
Patrick E. Garrett
Heidi L. Kraus
Edward W. Yee
Albert L. Ferro
Donald R. Banowitz
Peter A. Jackman
Molly A. McCall
Teresa U. Medler
Jeffrey S. Weaver
Kendrick P. Patterson
Vincent L. Capuano
Eldora Ellison Floyd
Thomas C. Fiala
Brian J. DeI Buono
Virgil Lee Beaton
Kimberly N. Reddick

Theodore A. Wood
Elizabeth J. Haanes
Bruce E. Chalker
Joseph S. Ostroff
Frank R. Cottingham
Christine M. Lhulier
Rae Lynn Prengaman
Jane Shershenovich
Lawrence J. Carroll
George S. Bardmesser
Daniel A. Klein
Rodney G. Maze
Jason D. Eisenberg
Michael D. Specht
Andrea J. Kamage
Tracy L. Muller
Jon E. Wright
LuAnne M. Yuricek

John J. Figueroa
Ann E. Summerfield

Registered Patent Agents*

Karen R. Markowicz
Nancy J. Leith
Helene C. Carlson
Gaby L. Longworth
Matthew J. Dowd
Aaron L. Schwartz
Mary B. Tung
Katrina Y. Pei
Bryan L. Skelton
Robert A. Schwartzman
Timothy A. Doyle
Jennifer R. Mahalingappa
Teresa A. Colella

Jeffrey S. Lundgren
Victoria S. Rutherford
Eric D. Hayes

Of Counsel
Kenneth C. Bass III
Evan R. Smith

*Admitted only in Maryland
*Admitted only in Virginia
•Practice Limited to
Federal Agencies

November 17, 2003

WRITER'S DIRECT NUMBER:

(202) 772-8560

INTERNET ADDRESS:

RESMOND@SKGF.COM

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Re: U.S. Utility Patent Application
Appl. No. 10/024,131; Filed: December 21, 2001
For: **Cloned Genes Encoding Reverse Transcriptase Lacking RNase H Activity**
Inventors: Kotewicz *et al.*
Our Ref: 0942.049000B/RWE/HCC

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Sixteenth Supplemental Information Disclosure Statement;
2. Form PTO-1449 (2 pages) citing four (4) documents;
3. Copies of the four (4) cited documents;
4. Seventeenth Supplemental Information Disclosure Statement;
5. Form PTO-1449 (3 pages) citing seven (7) documents;
6. Copies of the seven (7) cited documents; and
7. A return postcard.

Commissioner for Patents
November 17, 2003
Page 2

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Robert W. Esmond
Attorney for Applicants
Registration No. 32,893

RWE/HCC/AWL/tts
Enclosures

::ODMA\MHODMA\SKGF_DC1;186168;1
SKGF Rev. 2/15/02 dcw; 4/18/03 svb

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re application of:

Kotewicz *et al.*

Appl. No. 10/024,131

Filed: December 21, 2001

For: **Cloned Genes Encoding
Reverse Transcriptase
Lacking RNase H Activity**

Confirmation No. 4058

Art Unit: 1652

Examiner: Moore, William W.

Atty. Docket: 0942.049000B/RWE/HCC

Sixteenth Supplemental Information Disclosure Statement

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98. The numbering on this Sixteenth Supplemental Information Disclosure Statement is a continuation of the numbering in Applicants' Fifteenth Supplemental Information Disclosure Statement filed on March 13, 2003, in connection with the above-captioned application. A copy of each document is also provided.

Where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicants have listed publication dates on the attached PTO-1449 based on information presently available to the undersigned. However, the listed publication dates

should not be construed as an admission that the information was actually published on the date indicated.

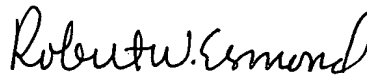
Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered. This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist.

This Information Disclosure Statement is being filed before the mailing date of a first Office Action on the merits. No statement or fee is required.

Consideration of the cited documents and making the same of record in the prosecution of the above-identified application is respectfully requested. The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Robert W. Esmond
Attorney for Applicants
Registration No. 32,893

Date: Nov. 17, 2003

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

FORM PTO-1449 SIXTEENTH SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT	ATTY. DOCKET NO. 0942.049000B/RWE/HCC	APPLICATION NO. 10/024,131
	APPLICANT Kotewicz et al.	
	FILING DATE December 21, 2001	GROUP 1652

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA						
	AB						
	AC						
	AD						
	AE						
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						

FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR		
	AS	<u>117</u>	Letter to Philip G. Hampton, II. from Marc R. Labgold, dated July 16, 2003, regarding <i>Invitrogen Corporation v. Clontech Laboratories, Inc.</i> , Civil Action Nos. AW-96-4080 and AW-00-1879
	AT	<u>117</u>	"Report and Recommendation Regarding Clontech's Motion for Partial Summary Judgement that the Claims of the Patents-In-Suit Are Invalid for Failure to Satisfy the Written Description Requirement of 35 U.S.C. § 112, First Paragraph," dated July 10, 2003, from <i>Invitrogen Corporation v. Clontech Laboratories, Inc.</i> , U.S. District Court for the District of Maryland, Southern Division, Civil Action Nos. AW-96-4080 and AW-00-1879

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

FORM PTO-1449 <u>SIXTEENTH SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT</u>	ATTY. DOCKET NO. 0942.049000B/RWE/HCC	APPLICATION NO. 10/024,131
	APPLICANT Kotewicz et al.	
	FILING DATE December 21, 2001	GROUP 1652

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA						
	AB						
	AC						
	AD						
	AE						
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						

FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

AR	<u>118</u>	Letter to Philip G. Hampton, II. from Robert J. Koch, dated July 18, 2003, regarding <i>Invitrogen Corporation v. Clontech Laboratories, Inc.</i> , Civil Action Nos. AW-96-4080 and AW-00-1879
AS	<u>118</u>	Letter to Robert J. Koch and Marc R. Labgold from Philip G. Hampton, II., dated July 23, 2003, regarding <i>Invitrogen Corporation v. Clontech Laboratories, Inc.</i> , Civil Action Nos. AW-96-4080 and AW-00-1879
AT		

EXAMINER

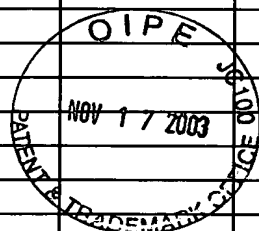
DATE CONSIDERED

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

FORM PTO-1449 SEVENTEENTH SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT	ATTY. DOCKET NO. 0942.049000B/RWE/HCC	APPLICATION NO. 10/024,131
	APPLICANT Kotewicz et al.	
	FILING DATE December 21, 2001	GROUP 1652

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA						
	AB						
	AC2	5,017,488	05/21/1991	McAllister et al.			10/17/1986
	AD						
	AE						
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						



FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR		
	AS		
	AT	118	Arnold, E., et al., "Structure of HIV-1 reverse transcriptase/DNA complex at 7 Å resolution showing active site locations," Nature 357:85-89, Macmillan Journals Ltd. (May 1992)

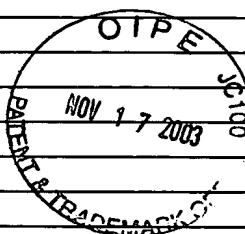
EXAMINER	DATE CONSIDERED
----------	-----------------

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

FORM PTO-1449 SEVENTEENTH SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT	ATTY. DOCKET NO. 0942.049000B/RWE/HCC	APPLICATION NO. 10/024,131
	APPLICANT Kotewicz et al.	
	FILING DATE December 21, 2001	GROUP 1652

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA						
	AB						
	AC						
	AD						
	AE						
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						



FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	<u>119</u>	Coffin, J.M., et al., "Reverse Transcriptase and the Generation of Retroviral DNA," in <i>Retroviruses</i> , Coffin, J.M., et al., eds., Cold Spring Harbor Laboratory Press, Plainview, NY, pp. 121-160 (January 1997)
	AS	<u>119</u>	Goedken, E.R., and Marqusee, S., "Metal binding and activation of the ribonuclease H domain from Moloney murine leukemia virus," <i>Prot. Eng.</i> 12:975-980, Oxford University Press (November 1999)
	AT	<u>119</u>	Keck, J.L., and Marqusee, S., "Substitution of a highly basic helix/loop sequence into the RNase H domain of human immunodeficiency virus reverse transcriptase restores its Mn ²⁺ -dependent RNase H activity," <i>Proc. Natl. Acad. Sci. USA</i> 92:2740-2744, National Academy of Sciences (March 1995)

EXAMINER	DATE CONSIDERED
EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.	

FORM PTO-1449 SEVENTEENTH SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT	ATTY. DOCKET NO. 0942.049000B/RWE/HCC	APPLICATION NO. 10/024,131
	APPLICANT Kotewicz et al.	
	FILING DATE December 21, 2001	GROUP 1652

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA						
	AB						
	AC						
	AD						
	AE						
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						

FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	<u>120</u>	Schultz, S.J., and Champoux, J.J., "RNase H Domain of Moloney Murine Leukemia Virus Reverse Transcriptase Retains Activity but Requires the Polymerase Domain for Specificity," J. Virol. 70:8630-8638, American Society for Microbiology (December 1996)
	AS	<u>120</u>	"Clontech's Notice Pursuant to 35 U.S.C. § 282," dated August 22, 2003, from Invitrogen Corporation v. Clontech Laboratories, Inc., U.S. District Court for the District of Maryland, Southern Division, Civil Action NO. AW 96-4080 and AW 00-1879
	AT		

EXAMINER	DATE CONSIDERED
EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.	